REMARKS/ARGUMENTS

The Examiner is thanked for the performance of a thorough search.

By this amendment, Claims 1, 3, 8-10, 12-13, 18-21, 25-28, and 32-34 are amended, Claims 35-37 are added, and no claims are cancelled. Hence, Claims 1-3, 5, 6, 8-10, 12, 13, 18-21, and 25-38 are pending in the application.

I. SUMMARY OF THE INTERVIEW

The Examiner and his supervisor are thanked for the in-person interview held on March 25, 2009. In the interview, representatives for the Applicants discussed (a) the objection of the dependent computer-readable storage medium claims and how they further limit the claims upon which they depend, and (b) the amendments to Claim 1 and the differences between Claim 1 and the cited art. In particular, representatives for the Applicants discussed the most-behind-first approach to selecting advertisements, the late-comer problem, and how the cited art and Claim 1 solve the late-comer problem differently. No agreement was reached.

II. SUMMARY OF THE OBJECTION/REJECTIONS

Claims 8-10, 12-13, 25-28, and 32-34 stand objected to under 37 C.F.R. § 1.75(c) as allegedly being in improper dependent form by failing to further limit the subject matter of a previous claim. Claims 8-10, 12-13, 25-28, and 32-34 are amended so that they do not depend on a method claim. Removal of this objection is respectfully requested.

Claims 1-3, 5, 8-10, 12, 18-21, and 25-34 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by WO 97/21183 to Shamin Naqvi et al. ("*Naqvi*"). This rejection is respectfully traversed.

Claims 6 and 13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Naqvi* in view of Official Notice. This rejection is respectfully traversed.

III. THE REJECTIONS BASED ON THE CITED ART

Claims 1-3, 5, 8-10, 12, 18-21, and 25-34 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by *Naqvi*.

A. CLAIM 1

Claim 1 now recites:

> A computer-implemented method for determining which advertisements to include with electronic content delivered to users over a network, the method comprising the steps of:
> after accepting a first contract with a first advertiser, accepting a second contract with a second advertiser;
> wherein the delivery obligations associated with the second contract are such that fulfillment of the second contract would adversely affect a level of service the first advertiser would otherwise receive under the first contract;
> receiving a plurality of advertisements from a plurality of advertisers;
> storing revenue information that indicates potential revenue amounts for the plurality of advertisements, wherein each of the plurality of advertisements is associated with corresponding delivery criteria and a corresponding contract of a plurality of contracts;
> wherein the plurality of contracts includes the first contract and the second contract;
> wherein the plurality of advertisers includes the first advertiser and the second advertiser;
> receiving, from a client that is not one of the plurality of advertisers, a request to provide over the network a piece of electronic content that includes a slot for an advertisement; and
> in response to receiving the request, performing the steps of:
> one or more computing devices comparing slot attributes of the slot with the delivery criteria of the plurality of advertisements to determine a first subset of the plurality of advertisements that qualify for inclusion in the slot,
> wherein the slot attributes of the slot include at least one of (a) the nature of the piece of electronic content, (b) the size of the slot within the piece of electronic content, or (c) the placement of the slot within the piece of electronic content;
> **the one or more computing devices creating a second subset of advertisements by filtering, out of the first subset of the plurality of advertisements, advertisements whose delivery obligations are on track to be satisfied**;
> wherein, after creating the second subset, both a first advertisement associated with the first contract and a second advertisement

associated with the second contract qualify for inclusion in said slot,

wherein the second contract is associated with a behindness value that is currently greater than a behindness value associated with the first contract,

wherein the behindness value of each contract reflects how far behind a content provider is on satisfying the delivery obligations associated with each contract; and

selecting the first advertisement from the subset of advertisements to include in the slot based, at least in part, on the potential revenue amounts;

inserting said first advertisement into the slot to create a modified piece of electronic content;

delivering, as a response to the request, the modified piece of electronic content to the user. (emphasis added)

At least the above-bolded feature of Claim 1 is not disclosed, taught, or suggested by *Naqvi*.

1. Naqvi *fails to teach or suggest accepting the second contract after accepting the first contract*

Both *Naqvi* and the invention recited in Claim 1 solve the problem with the most-behind-first approach. The problem is described in paragraph 16 of the present application:

> **[0016]** Unfortunately, the most-behind-first approach has some significant disadvantages that may lead to perceived or actual unfairness. For example, an advertiser may be interested in advertising in slots that are already subject to several pre-existing obligations. If the advertiser becomes aware of the pre-existing obligations, **the advertiser may contract for a much higher delivery obligation than the advertiser actually desires. The consequence of such a contract could be to significantly reduce the number of slots assigned to the previously contracted advertisers, while potentially given the latecomer advertiser exactly the number of slots the advertiser actually desires.** (emphasis added)

This problem is referred to herein as the "late-comer" problem. Although not identified as a problem, *Naqvi*'s system solves the late-comer problem. However, the way *Naqvi* solves the late-comer problem is fundamentally different than how the technique recited in Claim 1 solves the problem. Specifically, *Naqvi* avoids situations in which late-comers squeeze out prior orders by determining, before accepting a contract, whether that contract can be satisfied given

the pre-existing obligations of the already-accepted contracts. If not, then *Naqvi*'s system "suggests what coverage it can provide" (page 7, lines 16-22; see also page 41, lines 2-7). Thus, by ensuring, before accepting the contract, that the contract can be satisfied along with previously-accepted contracts, each previously-accepted contract is ensured to be satisfied. *Naqvi*'s approach can be accurately called a pre-acceptance filtering approach.

In contrast, Claim 1 recites that a second contract is accepted after accepting the first contract. This acceptance occurs even though "the delivery obligations associated with the second contract are such that fulfillment of the second contract would adversely affect a level of service the first advertiser would otherwise receive under the first contract." *Naqvi*'s system would not accept such a second contract.

2. Naqvi *fails to teach or suggest that a first ad is selected over a second ad despite the fact that the contract associated with the second ad has a greater behindness value than the contract associated with the first ad*

According to Claim 1, a first advertisement is selected based on potential revenue amounts despite the fact that the second contract has a behindness value that is greater than the first contract. *Naqvi* fails to teach or suggest this feature of Claim 1. Instead, *Naqvi* teaches that a contract may be one or more of 5 different types: frequency-based, ratio-based, exclusive-based, dependent-based, and story-based. It is not clear, however, how an advertisement is ultimately selected from a plurality of advertisements. *Naqvi*, in addition to describing the 5 types of contracts, merely states that "prime space manager 20 then looks at all the ad contracts and determines which advertisements to show to the user" (page 46, lines 27-29). Therefore, *Naqvi* fails to teach or suggest that ads are filtered at multiple stages in the manner claimed, i.e., (1) creating a first subset by comparing slot attributes of a slot to delivery obligations of the various contracts and (2) creating a second subset by filtering out (from the first subset) advertisements that are on track to be satisfied. The second subset includes two ads, one of

which has a behindness value that is greater than the other. Ultimately, (contrary to conventional approaches) the ad with a **lower** behindness value is selected. *Naqvi* does not disclose or suggest these express limitations.

Based on the foregoing, *Naqvi* fails to teach or suggest all the features of Claim 1. Therefore, Claim 1 is patentable over *Naqvi*. Reconsideration and withdrawal of the rejection of Claim 1 under 35 U.S.C. § 102(b) is therefore respectfully submitted.

B. CLAIM 8

Claim 8 recites the same features of Claim 1 discussed above. Claim 8 is therefore patentable over *Naqvi* for at least the same reasons given above for Claim 1.

C. CLAIMS 18 AND 25

Claim 18 recites some of the features of Claim 1 discussed above that render Claim 1 patentable over *Naqvi*. In addition, the Final Office Action does not cite any portion of *Naqvi* for disclosing certain features of Claims 18-21 and 29-31. If the Examiner believes another Office Action is necessary, then the Examiner is respectfully invited to cite specific portions of the references for all features of all the claims so that representatives for the Applicants can adequately respond.

Claim 25 recites the same features of Claim 18 discussed above. Claim 25 is therefore patentable over *Naqvi* for at least the same reasons given above for Claim 18.

D. DEPENDENT CLAIMS

The remaining claims are dependent claims, each of which depends (directly or indirectly) on one of the claims discussed above. Each of dependent claims is therefore patentable over the cited art for at least the same reasons given above for the claim on which it

depends. In addition, at least some of the dependent claims introduces one or more additional limitations that independently render them patentable over the cited art. However, due to the fundamental differences already identified and to expedite the positive resolution of this case a separate discussion of all those limitations is not included at this time, although the Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

IV. CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

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